

## REMARKS

Applicants have overcome the rejection of claims 1, 3, 25 and 27 in paragraph 3 of the Action by deleting the phrase “substantially free from slip additives” from the claims. This amendment does not narrow claim scope and thus does not bring into play prosecution history estoppel under the *Festo* case.

Claims 1-8 and 10-16 stand rejected under 35 USC 103(a) on Tsuchiya alone. Claims 9, 17, 18, 33, 41 and 42 stand rejected under 35 USC 103(a) on Tsuchiya in view of Kurokawa. Claims 19, 20, 43 and 44 stand rejected under 35 USC 103(a) on Tsuchiya in view of Tanizaki. Claims 24 and 46 stand rejected under 35 USC 103(a) on Tsuchiya in view of Yokoyama and Akao. Claims 25-32 and 34-40 stand rejected under 35 USC 103(a) on Tsuchiya in view of Yokoyama. In paragraphs 5 and 9 of the Action, the Examiner said, “Regarding the limitation of ‘wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film’ under 9% elongation includes zero, which is met by Tsuchiya.” These rejections are respectfully traversed.

All of the prior art rejections of record are based on Tsuchiya, and all of them should be withdrawn because of the Examiner’s apparent misunderstanding of the claim language. The limitation of “the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film” refers to the barrier durability of the claimed film, expressed in terms of oxygen transmission rate “under” or “at”<sup>1</sup> a test condition in which the oxygen transmission rate is tested while the film is subjected to a 9% elongation. This limitation does not refer to a property of the film itself which can be compared with Tsuchiya’s film. The test method referred to in the limitation is explained at the bottom of page 10 of the specification, which makes it clear that 9% elongation is a *test condition* at which oxygen

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<sup>1</sup> In order to dispel any potential misunderstanding on this point, applicants have amended the claims in which this limitation appears to replace “under” with “at.” If the Examiner believes that the claim amendments do not overcome this misunderstanding, applicants respectfully request him to telephone their undersigned attorney to discuss claim language that the Examiner will find satisfactory.

transmission rate is measured in order to determine whether a given laminate film meets the barrier durability requirements of the claims. The method of measuring oxygen transmission rate is explained starting at the next to last line on page 9 of the specification as being based on ASTM D3985.

The declarations of Messrs. Kurokawa and Chang already of record show that when Tsuchiya's film was tested without any elongation, i.e., under zero elongation, the barrier durability results obtained were far worse than the claimed results.<sup>2</sup> Furthermore, it is apparent to any person of ordinary skill in this art that the barrier properties of a film when it is stretched will be poorer than the properties of the same film when it is not stretched. Thus, if Tsuchiya's film were measured at a degree of stretching of 9% elongation as required by the claims, the barrier properties would be even worse than the bad properties observed under zero elongation (i.e., no stretching)!

The Examiner seems to dismiss the barrier property limitation as a process limitation in a product claim that is entitled to no patentable weight. This is incorrect. First, the limitation does not on its face purport to describe how the claimed product is made, so it is not by definition a product-by-process limitation. Second, the limitation clearly sets forth a *physical* property of the claimed film, barrier durability as measured in terms of oxygen transmission rate at a stated test condition, irrespective of how the claimed film was made. The products of the prior art do not exhibit this claimed physical property and in fact, as applicants have shown by evidence already of record, exhibit film barrier properties that are so much worse than this claimed film barrier property that persons of ordinary skill in the art would not have been motivated to make the

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<sup>2</sup> Applicants also note for the Examiner's consideration that Tsuchiya's films were tested at a variety of optical densities of the aluminized layer. The results explained in paragraph 5 of Mr. Chang's declaration show that even at optical densities as high as 4, Tsuchiya's films exhibited inferior moisture and barrier durability properties. This is evidence that persons of ordinary skill in the art would not have been motivated by Tsuchiya to use optical densities as low as the 2.6 optical density claimed and would not have believed that manipulating the optical density of the aluminized layer would produce barrier durability as good as claimed in this application.

claimed films based on their disclosures. The evidence of record overcomes any *prima facie* case of obviousness that the cited references could possibly make out.

All of the prior art rejections rely on Tsuchiya, whose inapplicability applicants have demonstrated. The secondary references do not, and are not cited to, overcome these deficiencies in Tsuchiya. Accordingly, all of the prior art rejections should be withdrawn.

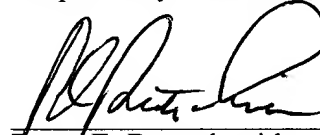
In light of the above, early allowance of claims 1-20, 24-44 and 46 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 361752000500.

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